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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,530	01/26/2001	Takahiro Miyoshi	010032	4911

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EXAMINER

QIN, YIXING

ART UNIT PAPER NUMBER

2625

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/769,530

Applicant(s)

MIYOSHI ET AL.

Examiner

Yixing Qin

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 3-7 and 9-16 is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

In response to applicant's amendment received 5/1/06, all requested changes have been entered.

### ***Response to Arguments***

Applicant's arguments filed 5/1/06 have been fully considered but they are not persuasive. The argument is that the Tang reference does not teach/suggest the newly amended claim which includes the line "converts the data into imaging data before receiving a print execution command." Tang, as previously mentioned, discloses the retention of a print job in column 4, lines 38-63, with lines 48-50 indicating that a print job may either be stored as a data file or a rasterized file (i.e. an imaging file as being claimed). Tang further discusses "Simple Retention" in column 6, lines 66-67 and column 7, lines 1-25. The first sentence describes this technique as enabling a user to download a file to printer to be stored without printing the document. Then, a user can enable the printing of the copies later through the use of a menu (i.e. send a command to print data). This means that a file to be printed can be converted to imaging data prior to the reception of a print command. The previously cited Venkatraman reference, again, showed how a printer could receive information from the web. Please see the rejection below.

***Allowable Subject Matter***

Claims 1, 3-7, and 9-16 are allowed. The reasons for allowance have been address in the office action dated 7/15/05.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman (U.S. Patent No. 5,956,48) in view of Tang (U.S. Patent No. 6,160,629).

**Claim 8.**

Venkatraman discloses a printer comprising:

a control portion that accesses a Web page based upon an address of the Web page that is provided from outside, obtains data, (Venkatraman, Fig. 1a and column 4, lines 18-28).

It does not explicitly disclose “converts the data into imaging data before receiving a print execution command; a memory that stores the imaging data; and an image-forming portion that prints the imaging data in response to a print execution command that is provided from outside and specifies the imaging data.”

However, the secondary reference, Tang, discloses in column 4, lines 38-63 a description of the job retention functionality of a printer. Specifically, lines 48-50 disclose that the print job may or may not be stored as a rasterized file (i.e. that it is previously converted to imaging data prior to printing). Please also see column 6, lines 65-column 7, lines 1-25 for a description of the simple retention technique. The first sentence describes this technique as enabling a user to download a file to printer to be stored without printing the document. Then, a user can enable the printing of the copies later through the use of a menu (i.e. send a command to print data).

Venkatraman and Tang are combinable because both are in the art of accessing data to be printed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have obvious to have the web access printer of Venkatraman be

improved to be able to store and retain the data prior to print the data as in the Tang invention.

The motivation would have been to allow a user to print only those jobs deemed necessary to print.

Therefore, it would have been obvious to combine Venkatraman and Tang to obtain the invention as specified.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



YQ



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